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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,441	09/30/2003	Jorge Adams	03009-00	4133

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EXAMINER
DRODGE, JOSEPH W

ART UNIT	PAPER NUMBER
1723	

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/674,441	ADAMS ET AL.	
	Examiner	Art Unit	
	Joseph W. Drodge	1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 26-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19 of copending Application No. 10/892,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from claim 19 of '847 in either omitting the surfactant (claim 26) or including both an emulsifier and a surfactant, rather than merely a surfactant (claim 27). However the instant claims and claims of '847 commonly claim a composition with elements of oil-based mud, water-in-oil emulsion and polymer derived from water-soluble monomer.

Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/892,847, in view of claim 19 of '847. Claim 1 of '847 differs from instant claim 3 primarily in now also reciting the step of using a surfactant. However, claim 19 discloses oil-based mud contacting compositions as containing surfactant.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dymond et al patent 4,777,200. Dymond et al '200 disclose compositions comprising oil-based drilling mud (column 2, lines 35-44 and column 5, lines 5-12), a water-in-oil emulsion comprising a water soluble polymer (column 4, lines 57-68). It is immaterial whether the polymer is dissolved prior to contacting the mud, since only the composition end product is claimed.

Also disclosed are addition of emulsifiers, surfactant and water (column 3, lines 25-30 and lines 52-59) for claim 27; regarding claim 28, the composition is "well-dispersed" (column 4, lines 59-67).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al patent 5,763,523 in view of Thompson et al patent 4,913,585 (both of record). Chen et al disclose a composition of widespread use for separating solid phases from liquid phases, including refinery waste suspensions (column 19, lines 42-44), especially by flocculation (column 1, lines 13-15) comprising water-in-oil emulsions (column 3, lines 24-30) that contain water soluble polymers and monomers (column 3, lines 30-48), including monomers that may or may not be dissolved (column 19, lines 1-14), then mixed with the solid phase/liquid phase mixture being treated (as in column

39, lines 26-36 or part (b) of claim 15 of Chen) and the solid phase and liquid phases of the treated mixture then being separated by flocculation and gravity settling (column 19, lines 34-49).

The claims differ in requiring the composition and method being applied to an oil-based mud. However, Thompson et al teach waste oil drilling muds being treated by flocculation and dewatering to separate liquid and solid phases by the same or similar polymers and monomers to those used in Chen (Abstract, etc.). It would have been obvious to one of ordinary skill in the art to have utilized the composition and methods of Chen in treating oil drilling muds, since the monomers employed in Chen for the related separations of refinery waste have been proven effective for treating oil drilling muds by flocculation, dewatering and gravity separations.

Chen et al also disclose most of the dependent claim limitations:

Regarding claims 2-9 and 22-25, numerous ones of the monomers and copolymers claimed are listed by Chen et al at column 5, lines 1-67.

Regarding claims 10 and 12, wide ranges for polymer concentrations are given at column 6, lines 4-8.

For claim 11, use of dispersion techniques is given at column 20, lines 11-23

For claims 13-16, addition of surfactants is discussed at column 10, lines 43-column 11, line 19.

For claims 17 and 18 disclosed use of flocculation implies gravitational separation, and Examples 112-118 also suggest filtering.

For claim 19, use of stirring and agitation or mechanical mixers is included in numerous ones of the Examples.

For claim 20, adding of pre-dispersed oil such as paraffins is included at column 18, lines 56-59, and use of kerosene oil is found at column 11, lines 25-27.

For claim 21, Thompson is particularly directed to treatment of drilling muds (column 6, lines 12-18).

Applicant's arguments filed on June 20, 2006 have been fully considered but they are not persuasive.

It is argued that regarding claims 26-28, Dymond does not disclose a water-in-oil emulsion comprising a water soluble polymer or a composition effective for functioning as flocculents. It is submitted that Dymond explicitly discloses such water-in-oil emulsion and contained polymer at column 4, lines 55-67. The composition claim does not positively recite a flocculent.

It is argued for claims 1-25 that neither Thompson or Chen et al is concerned with flocculation of oil-based drilling muds. Flocculation of oil-based drilling muds is not a limitation of the instant claims, which primarily only require contacting of the oil-based mud with the composition.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

July 13, 2006

JOSEPH DRODGE
PRIMARY EXAMINER